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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNIU79.013AUS	6418

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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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i772

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,957

Applicant(s)

YAMAMOTO ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Rejections Withdrawn

1. Claims 1-2 rejected under 35 USC 102(b) as being anticipated by Wang in the last Office Action of December 9, 2004 has been withdrawn in view of the amendment filed on April 11, 2005.
2. Claims 1-2 rejected under 35 USC 102(e) as being anticipated by Hanaoka in the last Office Action has been withdrawn in view of the amendment.
3. Claims 1-2, 4 and 6 rejected under 35 USC 103(a) as being unpatentable over Sugawara in view of Hanaoka in the last Office Action has been withdrawn in view of the amendment.
4. Claims 1-3 and 5 rejected under 35 USC 103(a) as being unpatentable over Koyama in view of Hanaoka in the last Office Action has been withdrawn in view of the amendment.

Response to Arguments

5. Applicant's arguments with respect to claims 1-6 and new claims 7-8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takei (2004/0169290).

Takei relates to a surface protection film comprising a transparent base material film (page-3, paragraph-0051), a transparent adhesive layer formed on one side of the base (page-4, para-0055), and a transparent antistatic layer formed on the other side of the base (page-4, para-0067). The base material film includes polyethylene terephthalate (page-4, para-0053). The antistatic layer comprises a cationic compound such as quaternary ammonium salt (page-4, para-0069). However, Takei fails to teach that the surface protection film is configured to maintain transparency even after one-hour heat treatment at 150 degrees C. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have Takei's protection film exhibit the property of maintaining transparency even after one-hour of heat treatment at 150 degrees C because all the material of the protection film being the same in both the Takei reference and the instant application, and the utility of the protection film being in the same field liquid crystal display surface.

8. Claims 4 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Sugawara in view of Takei.

Sugawara relates to a transparent conductive substrate (1) comprising a transparent conductive thin film (4) on one side of the substrate and, an adhesive layer (5) adheres a transparent protective substrate (6) on another face of the film substrate. However, Sugawara fails to teach that the other side of the protective substrate is provided with an antistatic layer. Takei, as discussed above teaches the advantage of using an

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antistatic layer on the protective substrate for providing reduction in the generation of static electricity. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Takei's teaching of using antistatic layer on the protective substrate in the invention of Sugawara with the motivation to reduce the generation of static electricity to prevent electrification.

9. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama in view of Takei.

Koyama relates to a transparent conductive substrate (6) support comprising a conductive film (5) on one side and a hard coat layer 94) on the other side of the substrate. However, Koyama fails to teach the presence of a protective film thereon. Takei, as discussed above, teaches the advantage of using a protective film to reduce the generation of static electricity and protect the substrate from soiling. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Takei's teaching of using a protective film on the conductive substrate in the invention of Koyama with the motivation to provide protection from adverse environment.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8, as stated is found to be confusing because recites pyrrolidinium ring containing polymer for antistatic layer but said claim depends from claim 1 which requires that the antistatic compound be cationic. Further, specification, page-12 teaches the antistatic compounds but fails to show that the cationic compound and the pyrrolidinium ring containing compounds are not the same. Therefore, claim 8 does not further limit the claim 1.

Allowable Subject Matter

12. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art uncovered so far fails to teach the use of pyrrolidinium ring containing polymers as the antistatic layer as claimed.

Drawings

13. With the preliminary amendment, applicant filed request to correct the drawing by adding "prior art" to figure-1. However, the correction shows that figure-3 has the phrase. Applicant is requested to clarify the confusion as to which drawing should be labeled as prior art and submit corrected drawing to said effect.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

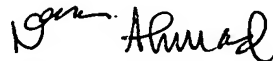
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
July 6, 2005.